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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/551,252	04/18/2000	Adolf Brodbeck	(K) 53 928	1754

7590 02/21/2007
M Robert Kestenbaum
11011 Bermuda Dunes NE
Albuquerque, NM 87111

EXAMINER

DEXTER, CLARK F

ART UNIT	PAPER NUMBER
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3724

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/551,252

Applicant(s)

BRODBECK ET AL.

Examiner

Clark F. Dexter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18,20-34 and 36-40 is/are pending in the application.
- 4a) Of the above claim(s) 20-34 and 36-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18,39 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The response filed on December 9, 2006 has been entered. While the Examiner respectfully acknowledges applicant's effort to clarify the invention, and that such effort is appreciated, it is respectfully submitted that many questions still exist regarding the specific operation of the invention.

Drawings

2. The drawings are objected to because of the following informalities:

In Figure 1, the lead line for numeral 26 indicates the same feature as the lead line for numeral 16, and it seems that numeral 26 and its lead line should be deleted; also, it seems that numerals 17 and 18 should be added corresponding to unit 30 for clarity; also, it seems that numeral 19 with an arrowheaded lead line should be added for unit 30 for clarity.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

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consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities:

These objections are directed to the specification as submitted in the substitute specification filed on April 3, 2002:

In paragraph 0002, line 1, it seems that the comma "," is improper and should be deleted for clarity.

In paragraph 0014, line 1, it seems that "right" is inaccurate and should be changed to --left--.

In paragraph 0015, line 1, it seems that "left" is inaccurate and should be changed to --right--.

In paragraph 0018, line 1, it seems that "has" should read --includes-- or the like for clarity; also, in line 1, the structure corresponding to numeral 26, i.e., the threaded spindle, is not shown in the drawings, and thus it seems that "26" should be changed to --(not shown)-- or the like; in line 2, the corresponding guide element is not shown, and

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thus it seems that --(not shown)-- should be inserted after "element" or the like; in each of lines 2, 3 and 4, it seems that numeral 26 should be deleted.

In paragraph 0019, line 2, --(not shown)-- should be inserted after "drive shaft" for clarity, and numeral 26 should be deleted.

In paragraph 0020, line 1, it seems that "a threaded spindle" should be change to --the threaded spindle-- since one have already been described; in line 2, it seems that "a motor" should be changed to --the motor 27-- since it seems that the motor being described has already been introduced; also in line 2, --17-- should be inserted after "slide" for clarity.

In paragraph 0022, line 1, "slide 17" appears to be inaccurate, and it seems that it should be changed to --guide rail 16--; in line 2, "tool 19" is unclear since numeral 19 is not shown as being associated with unit 30, and it seems that "19" should be changed to --33-- or the like; also in line 2, "a motor-driven cutting tool" is unclear as to how it relates to that which has been previously described, and it seems that it should be changed to --the cutting tool 19, which is driven by motor 37-- or the like.

In paragraph 0025, line 1, "cutting knife 33" is unclear since numeral 33 is not shown as being associated with unit 35, and it seems that "cutting knife 33" should be changed to --cutting tool 19, in the form of a cutting knife 33, -- or the like.

In paragraph 0026, line 2, numeral 13 should be inserted after "counter-holder" for clarity; in line 6, the interchanging uses of tool 19 and knife 33 is confusing, and it seems that "knife 33" should be changed to --tool 19-- or the like; similarly, in each of lines 8, 9 and 12, it seems that "knife 33" should be changed to --tool 19-- or the like.

In paragraph 0027, line 1, it seems that --19-- should be inserted after "cutting tool" or the like for clarity; in line 6, "by" is incorrect and should read --be--.

In paragraph 0028, line 1, the recitation " , as the unit 35 shows" is unclear, and it seems that it should be changed to --of unit 35-- or the like; in line 2, numeral 13 should be inserted after "counter-holder" for clarity; in line 3, "the ejector sleeve" should be changed to --an ejector sleeve-- or the like; in line 5, the recitation "a groove 42 or a correspondingly formed recess on the bolt 39" is unclear, particularly with respect to the structure shown in the drawings, specifically Figure 1, where numeral 42 indicates structure that appears to be a protruding structure, not a groove or recess.

In paragraph 0031, line 4, it seems that --be-- should be inserted after "it can" or the like; in line 5, "so that" occurs twice in a row (in lines 5-6), and it seems that one occurrence should be deleted.

In paragraph 0032, lines 9-10, the reference to "four o'clock or eight o'clock position" appears to be inaccurate, particularly in view of Figure 2 where the rollers are shown in positions that would correspond to the upper half of a clock face (e.g., a ten o'clock or two o'clock position); line 21, "drive rollers 46" is inaccurate and should be changed to --guide rollers 46-- or the like.

In paragraph 0035, line 2, it seems that --equipment and control-- should be inserted after "processing" or the like for clarity.

Appropriate correction is required.

Claim Rejections - 35 USC § 112, 1st paragraph

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 18, 39 and 40 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As stated in the previous Office actions, the operator of the ejector is not clear, particularly as to how it cooperates with the cutter and how it ejects a workpiece. More specifically:

- In paragraph 0018, a description is provided for a guide rail 16, a slide 17, and a threaded spindle 26 (not shown). However, the threaded spindle 26 is not shown, and the “corresponding guide element” which engages the threaded spindle is not shown and not sufficiently described. Thus, the connection between the slide 17 and the threaded spindle 16 is unclear, and thus it is not clear how the slide 17 is moved on or with respect to the guide rail 16.
- In Figure 1, elements are shown as being connected to the guide rail 16; specifically, undriven cutting unit 30 is connected to the guide rail 16, fixed cutting unit 53 is connected to guide rail 16, and driven cutting unit

35 is connected to guide rail 16. However, it is not clear as to how the ejector 21 is connected to the guide rail 16. Further, it is not clear how the cutting units and the ejector are independently moved/positioned along the guide rail 16. For example, it is not clear how the ejector 21 is moved with respect to the counter-holder 13. If the ejector is supported for such movement on the guide rail 16, it is not clear how the ejector 21 can move from the initial position 23 to the ejector position 24 without interference (i.e., running into) at least the cutting units 30 and 53.

- Further, it is not clear whether the cutting units 30, 53 and 35 and the ejector 21 are each connected to the threaded spindle for movement along the guide rail 16. And if so, it is not clear how they are separately controllable and/or positionable to attain the described cutting arrangement(s) to produce different length tubes, particularly as now claimed in claim 39, lines 10-11.
- Additionally, the structure of the ejector 21 is not clear. It is not clear whether the ejector 21 and the cutting unit 35 are connected together as a single unit or whether they are separate, independently movable units. If the ejector 21 is not connected to the cutting unit 35, then it is not clear how or even if it is connected to the guide rail 16 and/or the threaded spindle 26 (not shown). Also, the structure of the ejector is not clearly disclosed. For example, as stated above, groove 42 as shown in Figure 1 appears to indicate a protruding structure that is on the left side

of what appears to be a groove or recess, indicated by numeral 41.

Also, it is not clear as to what movable bolt 39 is connected and how it is arranged.

The above list of questions, which is not necessarily an exhaustive list, cover many of the questions raised by the present disclosure. As has been stated, it remains unclear as to what is the specific structure to perform the functions attributed to the present invention.

6. Claims 18, 39 and 40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original disclosure does not appear to provide support for a slide carrying "an ejector sleeve, having a driver element extendable in a direction toward the counter-holder and engaging a seating of said ejector sleeve" as now set forth in claim 39. In particular, it is not clear as to what disclosed structure the terms "driver element" and "seating" refer.

Claim Objections

7. Claims 18, 39 and 40 are objected to because of the following informalities:

In claim 39, line 2, a hyphen "-" is missing between "counter" and "holder"; in line 3, the first comma "," is improper and it seems that it should be deleted; in line 12, "is freely" is improper, and "is" should read --are-- or the like.

Appropriate correction is required.

Claim Rejections - 35 USC § 112, 2nd paragraph

8. Claims 18, 39 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 39, lines 7-8, the recitation "ejector sleeve" is vague as to whether it refers to that previously set forth or to another such ejector sleeve; in line 8, "having" is vague as to what it refers; also in line 8, the recitation "a driver element" is vague and indefinite as to what disclosed structure it refers; in line 9, the recitation "a seating" is vague and indefinite as to what disclosed structure it refers.

Claimed Subject Matter With Respect to Prior Art

9. Claims 18, 39 and 40 are considered to read over the prior art of record because the prior art or record does not teach or suggest the claimed combination of features including "a slide carrying the at least one cutting tool and ejector sleeve, having a driver element extendable in a direction toward the counter-holder and engaging a

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seating of said ejector sleeve" as now claimed. However, these claims **cannot** be considered to be "allowable" at this time due to the rejection(s) under 35 U.S.C. 112, 1st paragraph set forth in this Office action. Therefore, upon the claims being rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action, further consideration of these claims with respect to the prior art will be necessary.

Response to Arguments

10. Applicant's arguments filed May 22, 2006 and December 9, 2006 have been fully considered but they are not persuasive.

It is respectfully submitted that applicant's arguments directed to the rejection under 35 USC 112 have been considered but are not considered to obviate the outstanding rejections for at least the reasons further explained above under the corresponding rejections.

Applicant's arguments with respect to the prior art rejections have been considered but cannot be considered to be persuasive in view of the outstanding rejections under 35 USC 112, 1st paragraph.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

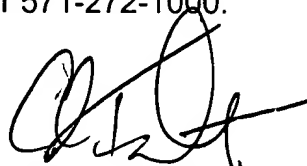
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Clark F. Dexter', is positioned above the printed name.

Clark F. Dexter
Primary Examiner
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cf
February 8, 2007